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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/848,727	05/03/2001	Vincent Jen-Jr. Gau	5876P002	8418

7590                    09/24/2002

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[REDACTED] EXAMINER

TRAN, MY CHAU T

ART UNIT	PAPER NUMBER
1641	

DATE MAILED: 09/24/2002

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Please find below and/or attached an Office communication concerning this application or proceeding.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>
	09/848,727	GAU, VINCENT JEN-JR.
	<b>Examiner</b>	<b>Art Unit</b>
	My-Chau T. Tran	1641

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 1 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

- 1) Responsive to communication(s) filed on 30 July 2002.
- 2a) This action is FINAL.                  2b) This action is non-final.
- 3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

- 4) Claim(s) 1-50 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) Claim(s) \_\_\_\_\_ is/are allowed.
- 6) Claim(s) \_\_\_\_\_ is/are rejected.
- 7) Claim(s) \_\_\_\_\_ is/are objected to.
- 8) Claim(s) 1-50 are subject to restriction and/or election requirement.

#### Application Papers

- 9) The specification is objected to by the Examiner.
- 10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- 11) The proposed drawing correction filed on \_\_\_\_\_ is: a) approved b) disapproved by the Examiner.  
If approved, corrected drawings are required in reply to this Office action.
- 12) The oath or declaration is objected to by the Examiner.

#### Priority under 35 U.S.C. §§ 119 and 120

- 13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) All b) Some \* c) None of:
1. Certified copies of the priority documents have been received.
  2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.
- 14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).  
a) The translation of the foreign language provisional application has been received.
- 15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

#### Attachment(s)

- |  |  |
|--|--|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892)                               | 4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____ . |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)           | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)  |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ . | 6) <input type="checkbox"/> Other: _____ .                                   |

## **DETAILED ACTION**

### ***Election/Restrictions***

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:
  - I. Claims 1-20, are drawn to a method of detecting the presence or measuring the quantity of a target analyte, classified in class 436, subclass 55.
  - II. Claim 21, is drawn to a method of detecting the presence or measuring the quantity of one molecule in a sample reagent, classified in class 436, subclass 149.
  - III. Claim 22, is drawn to a microfabricated electrochemical biosensor, classified in class 435, subclass 287.2.
  - IV. Claims 23-33, are drawn to a method of detection of a target analyte, classified in class 435, subclass 174.
  - V. Claims 34-40, are drawn to a device for detecting a redox event with micro electromechanical systems, classified in class 422, subclass 82.01.
  - VI. Claims 41-50, are drawn to a device for detecting a redox event with a counter electrode, classified in class 422, subclass 50.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions of Group I (process) and Group III (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and

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materially different process such as the method of DNA synthesis or Group IV. This restriction requirement is also applicable with the apparatus of Groups V and VI.

3. Inventions of Group II (process) and Group III (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of protein synthesis or Group IV. This restriction requirement is also applicable with the apparatus of Groups V and VI.

4. Inventions of Group IV (process) and Group III (apparatus) are related as process and apparatus for its practice. The inventions are distinct if it can be shown that either: (1) the process as claimed can be practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case the apparatus as claimed can be used to practice another and materially different process such as the method of Group I. This restriction requirement is also applicable with the apparatus of Groups V and VI.

5. Inventions of Groups I, II, and IV are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04,

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MPEP § 808.01). In the instant case the different inventions the different inventions as claimed have different method steps and modes of operation. The method step of contacting a microfabricated electrochemical biosensor comprising of a substrate and two electrodes of Group I is not required by the claims of Groups II and Group IV. The method step of contacting a microfabricated electrochemical biosensor comprising of a substrate and three electrodes of Group II is not required by the claims of Groups I and Group IV. The method step of applying a volume of reagent to the biosensor of Group IV is not required by the claims of Groups I and Group II.

6. Inventions of Group III, V, and VI are unrelated and independent inventions. Inventions are unrelated if it can be shown that they are not disclosed as capable of use together and they have different modes of operation, different functions, or different effects (MPEP § 806.04, MPEP § 808.01). In the instant case the different inventions the different inventions as claimed have different required components. The feature of a silicon substrate of Group III is not required by the claims of Groups V and Group VI. The feature of a redox sensor that includes two conductive electrodes of Group V is not required by the claims of Groups III and Group VI. The feature of the redox sensor comprising a reference electrode, a working electrode, and a counter electrode of Group VI is not required by the claims of Groups III and Group V.

7. Because these inventions are distinct for the reasons given above and the searches required are not co-extensive thus requiring a burdensome search, restriction for examination purposes as indicated is proper. Additionally, different patentability considerations are involved

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for each group. For example, a patentability determination for Group III would involve a determination of the patentability of the combination of silicon substrates and three conductive electrodes (independent of its use) while a patentability determination for Group IV would involve a consideration of the patentability of an area having a surface property for immobilizing the target analyte. These considerations are very different in nature.

8. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.143).

Any inquiry concerning this communication or earlier communications from the examiner should be directed to My-Chau T. Tran whose telephone number is 703-305-6999. The examiner can normally be reached on M-F 8:00-4:30.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Long V. Le can be reached on 703-305-3399. The fax phone numbers for the organization where this application or proceeding is assigned are 703-308-4242 for regular communications and 703-872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is 703-308-0196.

mct  
September 21, 2002

  
LONG V. LE  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 1600

